



**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** RONALD JOHN ROSENBERGER  
**Application No.:** 09/634,612 **Art. Unit:** 3622  
**Filing Date:** August 5, 2000 **Examiner:** James W. Myhre  
**Title:** HEALTH REMINDERS FOR END USERS OF FINACIAL CARD SERVICES (REVISED)  
**Mail Stop AF**  
**Commissioner for Patents**  
**P. O. Box: 1450**  
**Alexandria, VA 22313-1450**

**CERTIFICATE OF MAILING**

I, Ronald Rosenberger, hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 23, 2005

*Ronald Rosenberger - 9/23/05*

**PRE-APPEAL BRIEF REQUEST AND REMARKS**

Dear Sir:

Applicant requests review of the final rejections in the final Office Action, mailed June 23, 2005, for which a response was timely filed by Applicant on July 23, 2005, and an Advisory Action then mailed on August 3, 2005, by the Examiner, maintaining the pending rejections, in connection with the US Patent Application identified above. No amendments are being filed with this request and with Notice of Appeal being filed with this Pre-Appeal Brief. This review is requested for the reasons stated in the following remarks relating to the single remaining rejection of the claims for obviousness, which remarks are less than 5 pages.

### REMARKS

Claims 146-205 are pending in this application. There are no claim amendments provided in this request. For reference a clean copy of the pending claims are provided in Appendix A in the response filed July 23, 2005, by Applicant to the final Office Action dated June 23, 2005.

Applicant requests pre-appeal review of the only remaining rejection of claims 146-205 under 35 USC 103(a) (as presented on pages 2-9 of the final Office Action) as obvious over the combination of Byerly and Bucci, of record, in view of Masuda (US patent No. 5,569,897).

Applicants respectfully submit that the Examiner has made clear errors and omissions in this rejection because one of ordinary skill in the art would not be taught or motivated to make the presently claimed transaction card purchases of items other than those relating to the health reminders, using the combination of Byerly et al and Bucci, in view of Masuda (5,569,987), which relate only to health information specific to the prescription purchases made normally provided by a pharmacy for purchased drugs, and that the references teach away from the presently claimed invention.

The Examiner has mischaracterized the cited references by ignoring the features of the subject matter taught by the references and picking and choosing features of the present invention and improperly reading them into the cited references using impermissible hindsight provided by the present specification. This is clear error, as the motivation to combine the references must be provided by the cited references, which the cited references fail to do.

As presented beginning on page 2 of Applicants Amendment and Response to the final Office Action, dated July 23, 2005 (hereinafter, "Applicant's Response"), the presently claimed invention relates to a method for providing medical or health reminder information in a statement for a financial card or account, where the health information is not related to purchases made using the financial card or account (see, for example, Claim 146 in Appendix A of Applicant's Response).

As presented on pages 2-3 of Applicant's Response, Byerly merely teaches adding medical advisory information to pharmacy transaction information that is relevant to the pharmaceutical for which the patient had bought through the use of a doctor's prescription. This aspect of Byerly is specifically excluded from the present claims such that Byerly cannot suggest or teach the presently claimed invention.

As presented beginning on page 3 of Applicant's Response, Bucci is completely unrelated to Byerly, in that Bucci teaches the electronic or computer combination of several financial services transaction accounts into a single printed transaction statement. The cited art must provide a motivation to combine the references and the cited references fail to provide such a motivation.

Thus, the Examiner has made clear errors in his characterization of Byerly and Bucci, which are completely unrelated to each other and also do not in any way teach or suggest the presently claimed method. Byerly and Bucci teach away from each other and thus cannot be properly combined either with each other or together with Masuda. Additionally, the asserted combination can only be combined using impermissible hindsight of the teaching of the present specification, as presented beginning at page 3 of Applicant's Response.

Additionally, as presented beginning at page 3 of Applicant's Response, the combination of Masuda and Byerly et al would require that Byerly et al teach a credit card issuer, which Byerly completely fails to do. There is no possible relationship between Masuda and Bucci because Bucci also fails to teach or suggest a credit card issuer, where Bucci merely teaches to consolidate bills into a single statement, which has no relationship to the presently claimed invention.

The "teach away" descriptions presented by Byerly et al and Bucci are presented in more detail beginning on page 3 of Applicant's Response. In particular, the evidence and art of record as discussed on pages establishes that Bucci and Byerly et al "teach away" from each other in three ways: 1) with regards to method of delivery of materials to the end user (pages 4-5 of Applicant's Response); 2) with regards to

periodicity of the receipt of materials by the end user (pages 5-6 of Applicant's Response); and, 3) with regards to when payment is made in relation to the consumption of products or services (pages 6-7 of Applicant's Response). In light of the fact that the references "teach away" from each other in all of these ways, there is nothing in either of the references that would suggest that the motivation for combining the references is known outside of the teaching of the present specification. As a result, the combination can at best be obvious in hindsight, which is impermissible, according to the MPEP. Accordingly, Byerly and Bucci cannot be combined, and thus cannot also be combined with Masuda, as presented in detail on pages 3-7 of Applicant's Response.

Additionally, as presented on page 4 of Applicant's Response, the Examiner has made clear error in combining the cited references because the MPEP specifically prohibits the type of combination that the Examiner has made in this rejection, for example, at section 2143.01, and especially as described in detail in this section under the headings toward the end of the section "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" and "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE".

Accordingly, the Examiner has failed to establish a prima facie case of obviousness and Applicant requests that the Pre-Appeal Review panel reconsider and withdraw this rejection for all of the pending claims.

Respectfully submitted,

/Guy Kevin Townsend/

Guy Kevin Townsend

Reg. No. 34,033

Attorney-Agent for Applicant

**Date:** September 23, 2005